

REMARKS

This amendment under 37 C.F.R. § 1.111 is being submitted in response to the outstanding Official Action mailed August 24, 2004. In view of the above claim amendments and the following remarks, reconsideration and allowance of this application is respectfully requested.

Claim 1 has been amended to more particularly point out and distinctly claim the subject matter that applicant regards as the invention. In particular, claim 1 has been amended to state that each property is within an area where a wireless communications facility is needed for a wireless communications network and contains a location desirable for positioning said facility. This was disclosed in original Claim 3 (now cancelled) and does not introduce new matter. Claim 1 has also been amended to require the total rent payment to be less than the aggregate projected periodic lease payments for each property over the term of use. This is disclosed throughout the specification, for example, at page 9, lines 16 – 18. Finally, Claim 1 has been amended to remove the “scenarios and choices” language objected to by the Examiner, which also does not introduce new matter.

Claims 4 – 6, 16 – 19 and 22 – 25 have been amended to depend from Claim 1 instead of from cancelled Claim 3, the subject matter of which has been introduced by amendment to Claim 1. This also does not introduce new matter.

Claim 5 has been amended to define the wireless communications facility as being part of a wireless communications network. This is disclosed in the specification at page 5, line 16. Claim 10 has been amended to recite that the lump sum payment is made in lieu of periodic rent payments and does not require the payment to be made within 90 days. This is disclosed in the specification in the first paragraph of page 6 and the last paragraph of page 10. These changes also do not introduce new matter.

Claims 12 and 15 have been amended to remove the “reasonable degree of liquidity” language objected to by the Examiner. Claim 13 has been amended to remove the

requirement that the securities of Claim 12 be stock or stock options in the company acquiring the property rights. This likewise does not introduce new matter.

Finally, Claims 5, 17, 18, 20 and 21 have been amended to clarify that “if necessary” refers to property access. In particular, the claims have been amended to refer to parcels of land “and any necessary access,” which also does not introduce new matter.

Instead, in view of the foregoing amendments, the claims are believed to be in condition for allowance. The claim amendments are believed to resolve the concerns raised by the Examiner to which they are addressed. Accordingly, reconsideration is respectfully requested. In the event any issues remain outstanding, the Examiner is asked to call the undersigned at the telephone number indicated below.

Turning to the Official Action, the Examiner objected to the application as being directed to non-statutory subject matter. There is no specific rejection of any claim under 35 U.S.C. §101. The Examiner only states, “The claimed invention is directed to non-statutory subject matter.” The reason given by the Examiner is that the claimed invention “is not tied to tech-nological art, environment or machine.” According to the Examiner, citing Ex parte Bowman, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001) (unpub.), because the claims are direct-ed toward processes that can be performed manually, they are directed to “nothing more than an abstract idea which is not a useful art as contemplated by the [C]onstitution.” This reject-tion is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

Ex Parte Bowman does not state that all processes based on manual calculations represent abstract ideas, or that all processes based on manual calculations can never be considered tied to a technological art or environment. All Ex Parte Bowman states is that processes based on manual calculations that are not tied to a technological art or environment represent abstract ideas. Whether manual calculations are used is not dispositive. Rather, what is dispositive is whether the results of the manual calculation are used in a tangible way.

In Ex Parte Bowman, the claims were rejected as non-statutory for being directed to an abstract idea because they were not tied to any technological art or environment. The invention involved nothing more than a human making mental computations and plotting the results on a paper chart. The chart was then used to make at least one decision regarding the value of an undefined intangible asset.

Claim 1 of the present application has been amended so that it is now limited to property lease acquisition methods in which a plurality of properties are each within an area where a wireless communications facility is needed for a wireless communications network and each contains a location desirable for positioning a facility. While computations that can be performed manually are employed, they result in the step of tendering to each property owner a defined lease acquisition offer comprising an offer to lease each property for a term of years with a lump sum payment as consideration, wherein each lump sum payment is less than the aggregate projected periodic lease payments for each property over the term of use.

The claims of the present application are therefore tied to a technological art, wireless communications. A tangible result is produced, a plurality of discounted lump sum offers permitting the acquisition of properties for the build-out of wireless communications networks at a reduced cost. Industry-wide implementation of this method would significantly improve the profitability of wireless communications companies without increasing costs to consumers at a time when competition is fierce and profit margins are razor thin, thereby promoting the progress of science and the useful arts.

Because Claim 1, as amended, is directed to method steps that promote the progress of science and the useful arts in a tangible way, Claim 1 and the claims depending therefrom are directed to statutory subject matter under 35 U.S.C. §101. By amending Claim 1 to identify a technological art and incorporate a tangible result, this objection by the Examiner has thus been overcome. Reconsideration by the Examiner and acknowledgement that the invention is directed to statutory subject matter is respectfully requested.

Next, Claims 1 - 25 were rejected under 35 U.S.C. §112, first paragraph, as being based on a disclosure that is not enabling. The Examiner, citing In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976), stated, “A computer, which is essential to the practice of an invention within Business Methods, but not included in the claim(s) is not enabled by the disclosure.” This rejection is respectfully traversed for the following reasons.

In re Mayhew addresses chemical methods, i.e., galvanizing steel, not business methods, and states that claims which fail to recite features identified by the specification as critical are not enabled thereby. That is, if the specification treats a feature as essential, it cannot be considered enabling of an embodiment in which it is absent or treated as optional.

In the present specification, the use of a computer is not treated as critical. This was previously acknowledged by the Examiner in his rejection under 35 U.S.C. §101 in which he rejected the claims as being nothing more than an abstract idea because the mathematical processes could be performed manually, without a computer. While a computer can be used ancillary to the claimed method to perform calculations or generate spreadsheets, such a use is not critical to implementation of the claimed method and is so common-place that no description is required, just as one would be required to describe how to conduct linear measurement with a meter stick.

Because a computer is not critical to implementation of the method of Claims 1 – 25, and the specification does not treat it as such, the claims do not lack enablement for failure to recite the use of a computer. Because the method is capable of implementation without a computer, the claims do not lack enablement because the specification does not describe a computer-based means for implementing the method. Instead, the claims satisfy the enablement requirement of 35 U.S.C. §112, first paragraph in all respects. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Next, Claims 1 - 25 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. In Claim 1, the Examiner questioned the meaning of “suitable” with respect to “property,” and also the meaning of “scenarios and choices.” The Examiner also questioned the meaning of “if necessary” and “reasonable degree” in Claim 5. This rejection is respectfully traversed in view of the above claim amendments for the following reasons.

Claim 1 has been amended to delete “suitable” and “multiple scenarios and choices.” Claims 12 and 15 have been amended to delete “reasonable degree of liquidity.” Claims 5, 17, 18, 20 and 21 have been amended to change “any access thereto, if necessary,” to “any necessary access.” This clarifies that “necessary” refers to “access.” One skilled in the art of cellular network build-out understands the meaning of this term. A cellular communication tower site is useless unless it is accessible from a public road. Where direct access is not available, then this property right must be secured.

As noted above, the meaning of “necessary access” is known to those skilled in the art, so the metes and bounds of the claims in question are well understood and therefore adequately defined under 35 U.S.C. §112, second paragraph. By amending claims 1, 5, 12, 17, 18, 20 and 21 as explained above, this rejection under 35 U.S.C. §112, second paragraph has thus been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Finally, Claims 1 - 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over an SBA Communications Corporation publication and the company website. The publication and website were cited as disclosing that SBA provided communication site services to the wireless communication industry, including a broad array of site acquisition, zoning, construction and tower space leasing services. The Examiner noted that in typical property leasing agreements/purchase offers between tenants and landlords, terms and conditions such as lump sum payments can be negotiated, and concluded that it would have been obvious to one of ordinary skill in the art to negotiate on the basis of a variety of leasing

scenarios and choices. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

The Examiner is requested to identify the source for his statement that lump sum payments are conventional and typically negotiated in leasing agreements between tenants and landlords. Applicant does not understand this to be common to residential leases or commercial leases. It is an even greater leap of faith for the Examiner to go from this statement to the conclusion that it would be obvious to modify whatever lease terms are offered by SBA to include a front-end lump sum payment option, especially when the Examiner's original assumption does not differentiate between front-end and back-end lump sum payments. SBA only discloses what they do, not how they do it.

The advantages of front-end lump sum payments to the leasing of cellular communication tower sites over other payment options are depicted in the enclosed spreadsheets, which demonstrate that for large networks the savings over the lease term can approach one billion dollars. This can only be learned by reading the present application. The assumption that it would be obvious to incorporate a lump sum payment option into the lease terms offered by SBA thus represents the impermissible application of hindsight reconstruction based on Applicant's own disclosure.

Furthermore, Claim 1 has been amended to clarify that the total rent payment is less than the aggregate projected periodic lease payments for each property over the term of use, which further distinguishes Claims 1 – 25 over the cited and presumed state of the art. This is not simply a matter of dividing the total rent over a lease period between a front end payment, a back end payment and periodic payments. In the presently claimed method, the front end payment is coupled to a discount in the rent paid over the term of the lease as illustrated in the accompanying spreadsheets. Claim 10 has been amended to even further patentably distinguish over the cited and presumed state of the art by requiring that the lump sum payment be made in lieu of periodic rent payments, which represents an even more significant discount and embodies the invention as depicted in the enclosed spreadsheets.

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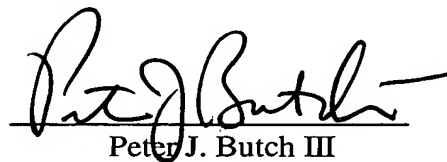
Because the discounting of payments over the term of a property lease through the use of a front-end lump sum payments can only be learned by reading the present specification, and because Claim 1 and the claims depending therefrom have been amended to require the total rent payment to be less than the aggregate projected periodic lease payments for each property over the term of use, Claims 1 – 25 patentably distinguish over the cited prior art under 35 U.S.C. §103(a). Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

In view of the above claim amendments and the foregoing remarks, this application is now in condition for Allowance. Reconsideration is respectfully requested. The Examiner is reminded to telephone the undersigned if there are any remaining issues in this application to be resolved.

Finally, if there are any additional charges in connection with this response, the Examiner is authorized to charge applicants' Deposit Account No. 19-5425 therefor.

Respectfully submitted,

Dated: January 26, 2005



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